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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/312,811	05/17/1999	MICHAEL A. GIARDELLO	PM-0261607	3077

7590 11/19/2002

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EXAMINER

TESKIN, FRED M

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/19/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/312,811

Applicant(s)

Giardello, et al.

Examiner

Fred Teskin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 13, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 18-20, 22, 23, 25, 27-32, and 34-43 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 and 37-43 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-8, 18-20, 25, 30-32, 35, and 36 is/are rejected.
- 7) ☒ Claim(s) 3-5, 22, 23, and 27-29 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 12 6) ☐ Other:

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1. Amendments presented in the Response of August 13, 2002 are acknowledged. Claims 1-8, 18-20, 22, 23, 25, 27-32 and 34-43 are currently pending and under examination.

2. With respect to the Information Disclosure Statement filed September 23, 2002, attention is drawn to the fact that the three references submitted are duplicates of references earlier submitted and considered by the examiner during prosecution herein. In this regard, note the identical reference citations, designated CR, AR and BR, on the Form PTO-1449 filed with the IDS of September 13, 1999. Accordingly, the duplicate citations on the Form PTO-1449 accompanying the latest IDS have been lined through.

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 2, 6-8, 18-20, 25, 30-32, 35 and 36 stand rejected under § 103(a) as being unpatentable over Setiabudi et al 6100323 ("Setiabudi").

The basis of the rejection is adequately set forth in the prior Office action (paper no. 9, pp. 4-7) and that explanation is incorporated herein by reference.

5. Applicants' arguments filed August 13, 2002 have been fully considered but are not persuasive of error in the repeated rejection.

Noting that the claims have been amended to read "consisting essentially of" instead of "comprising", applicants urge that the '323 patent (Setiabudi) requires an additive such as a basic adsorbent whereas in the present application, no such additive is required.

However, even if Setiabudi requires such an additive and applicants do not, this is not determinative of whether the language "consisting essentially of" closes the claims to such additive. The test is, rather, whether the unspecified additive would materially affect the basic and novel characteristics of applicants' composition as defined in the balance of the claim. See *In re Jankirama-Rao*, 137 USPQ 893, 896 (CCPA 1963).

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Instantly, the claims define no characteristic apart from "toughness and/or hardness modulators" (e.g., claim 1, final line). Setiabudi similarly characterizes as "tougheners" certain polymers and elastomers within the scope of the claimed modulators (col. 6, lines 10-15).

Moreover, even if other characteristics disclosed in the present specification were read into the claims, there is no evidence demonstrating that introduction of the Setiabudi-type additive, in amounts as taught therein (i.e., 2-95 % by weight; col. 1, lines 42-43), would materially change such characteristics. It is applicants' burden to show that the introduction of additional components would materially change the characteristics of their invention (see MPEP 2111.03). The burden is not met merely by asserting that the present invention does not require the additional component (basic adsorbent-containing filler) which is allegedly required by the reference.

Further in this regard, examiner notes that applicants own specification indicates that fillers may indeed be present in the inventive composition: "The polyolefin resins of the present invention ... are tolerant of additives, fillers and fibers ...". (Page 8, lines 27-30.)

Thus, on the present record examiner finds that the type of filler included in the curable composition of Setiabudi is not

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excluded from applicants' composition and process by the "consisting essentially of" language recited in claims 1, 18 and 25.

6. Claims 3-5, 22, 23 and 27-29 stand objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim.

7. Claims 34 and 37-43 are allowable over the prior art of record.

8. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

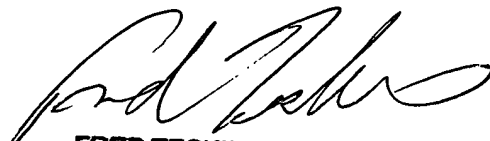
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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


FRED TESKIN
PRIMARY EXAMINER
1713

FMTeskin/11-15-02